IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Steven M. Shei — Art Unit 1761
Serial No. 10/698,693
Filed October 31, 2003
Confirmation No. 1911
For Food Warming Apparatus and Method
Examiner Reginald Alexander

July 2, 2007

PRE-APPEAL BRIEF REQUEST FOR REVIEW

TO THE COMMISSIONER FOR PATENTS,

SIR:

Applicant hereby requests review of the Office's final rejection of claims 39-59 in the Office action dated March 2, 2007 and Advisory Action dated June 25, 2007. A Notice of Appeal is being filed concurrently herewith.

While no fees are believed due with respect to this Request, the Commissioner is authorized to charge any fees due to Deposit Account No. 19-1345.

ARGUMENTS

BACKGROUND

Claim 39, the only independent claim of the pending application reads as follows:

39. Food holding apparatus for holding pre-cooked food at a selected holding temperature, said apparatus comprising:

a cabinet having a plurality of holding compartments for holding said pre-cooked food therein;

a heat source in each compartment of said plurality of compartments for delivering heat to the food in the compartment; and

a control mechanism programmed to vary the heat delivered by each heat source to the food in a respective holding compartment through a duration of holding time, said duration comprising a first phase during which the heat source operates at a first level and the food reaches said selected holding temperature, a second phase during which the heat source operates at a second level different from said first level to hold the food at said selected holding temperature, and a third phase at which the heat source operates at a third level different from said first and second levels to maintain the food at said selected holding temperature.

Thus, claim 39 specifies a control mechanism which is programmed to vary the heat delivered by each heat source during a duration of holding time. The duration of holding time comprises three distinct phases during which the heat source operates at three different levels (i.e., energy levels). By way of example, as illustrated in Fig. 9B and related text of the pending application, a heat source is operated at 100% of maximum power during a first phase P1 of a holding duration D to bring the temperature of the pre-cooked food up to the desired holding temperature as quickly as possible, at 0% of maximum power during a second phase P2 of the holding duration to allow the temperature of the food to stabilize at the selected holding temperature, and at 25% of maximum power during a third phase P3 of the holding duration to maintain the food at the selected holding temperature while using less power than in the first phase to extend the quality of the food. (Three phases are used as an example. There could be more phases. As stated in the application, the number of phases can vary.)

CLAIM REJECTIONS - 35 USC §102

Claim 39 and claims 40-43, 45-54 and 59 depending from claim 39 stand finally rejected as being anticipated by Arnold et al. U.S. Patent No. 6,011,243. For the reasons given below, it is submitted that this rejection is clearly erroneous.

Arnold et al. discloses a "hot box" type holding cabinet in which food in containers is heated by upper and lower heater plates 18a, 18b heated by heating elements. The heater plates are heated to a predetermined temperature by a control system using feedback from temperature sensors mounted on the heating plates. The operation of the control system is described in part in the paragraph starting in column 4, line 49 of the patent. To maintain the heating plates at the desired temperature (or within a desired temperature range), the heating elements are turned on

and off, as needed. Thus, the heating elements appear to operate at only two energy levels (e.g., 100% and 0%). There is no disclosure that the heating elements are even capable of operating at different intensity levels other than full on and full off, much less of operating at three different energy levels during three different phases of a holding duration.

The examiner has rejected claims 39, 40-43, 45-54 and 59 on the basis that

> "It should be noted that the operation of the heat source and other elements of the invention by the controller amount to nothing more than a desired operation of the device. Such an operation of the device is not structurally limiting and receives no patentable weight in an apparatus claim." (Page 3 of the Office action dated 3/02/07.)
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> "The three phases amount to a use of the heat source and controller and fail to provide any structural limitations to the apparatus claims. Since the controller of Arnold is programmable, it is apparently capable of being programmed to operate the heat source, which is itself capable of different intensity levels, in phases as claimed. Thus, all of the claimed structural elements have been met by the prior art." (Page 5 of the Office action dated 3/02/07.)

This rejection under 35 USC §102 is clearly in error for at least two reasons.

First, claim 39 does not say that the control mechanism is "programmable" to perform the three different phases of heating. Rather, the claim clearly and positively states that the control mechanism is programmed to carry out the three specific phases of heating. This programming is not a hypothetical operation; it is a structural limitation that cannot be ignored, i.e., an actual program embedded in the control mechanism. Even if the oven of Arnold et al. was capable of being programmed to carry out the claimed heating phases (and the truth of this assumption is not conceded for the reasons given below), there is no disclosure or suggestion that the oven is in fact "programmed" to perform this heating. Without this structural element, i.e., a program embedded in the control mechanism, there is no anticipation of the claimed invention by Arnold et al. To find otherwise would be to deny patent protection to all control programs, regardless of inventiveness, simply because someone with the hindsight knowledge of an invention has the capability of programming a controller to carry out the same methodology. This is neither the law nor the intent of the law.

Significantly, a claim directed to an apparatus comprising a control mechanism programmed to carry out the heating procedure of claim 39 is analogous to a method claim which specifies the same steps of the procedure. Such a method claim could not have been

properly rejected as describing "nothing more than a desired operation of the device ... and receives no patentable weight." The steps recited in a method claim are clearly entitled to receive patentable weight. Similarly, the control mechanism of claim 39 programmed to carry out these same steps is entitled to receive patentable weight, and the examiner's failure to do constitutes clear error.

Second, the examiner states (or at least infers) in his rejection that each of Arnold et al.'s heating elements is capable of operating at more than two different intensity levels. Applicant finds no support in the patent for this conclusion. Indeed, there is no need for any such heating element in Arnold et al. since operation of the heating element at two different intensity levels, e.g., 100% and 0%, would be sufficient to hold the food at a desired temperature using a sensor feedback system.

Accordingly, the rejection of claims 39-43, 45-54 and 59 under 35 USC §102 should be withdrawn.

CLAIM REJECTIONS - 35 USC §103

Claims 55 and 56 depend from claim 39 and are finally rejected as unpatentable over Arnold et al. in view of Fortmann et al. U.S. Patent No. 5,852,967. Applicant disagrees.

Claims 55 and 56 depend from claim 39 which recites the structural limitation of a control mechanism which is actually programmed (i.e., contains an embedded program) to vary the delivery of heat by the heat sources in the compartments to deliver heat in the prescribed manner, that is, in three separate phases during which a heat source operates at three distinct and different levels. As noted above in regard to claim 39, there is no disclosure or suggestion in Arnold et al. of applicant's 3-phase, 3-energy level feature and the attendant advantages thereof (e.g., improved food quality using less power). The patent to Fortmann et al. is similarly devoid of any such teaching.

Accordingly, claims 55 and 56 are submitted to be allowable.

Claims 44, 57 and 58 are rejected as unpatentable over Arnold et al. in view of Shei et al. (6,175,099). Applicant respectfully disagrees.

Claims 44, 57 and 58 depend, either directly or indirectly, from claim 39 which recites the structural limitation of a control mechanism which is actually programmed (i.e., contains an embedded program) to vary the delivery of heat by the heat sources in the compartments to

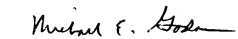
deliver heat in the prescribed manner, that is, in three separate phases during which a heat source operates at three distinct and different levels. As explained above, Arnold et al. fails to show or suggest this unique feature, and the Shei et al. patent is similarly devoid of any such teaching.

Accordingly, claims 44, 57 and 58 are submitted to be allowable.

CONCLUSION

The examiner's failure to give any patentable weight to a control mechanism programmed in the claimed manner is clearly erroneous. In view of the foregoing, favorable consideration and allowance of claims 39-59 is respectfully requested.

Respectfully submitted,



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